

### **REMARKS/ARGUMENTS**

Claims 13-40 are pending in the application. By this Amendment, claims 1-12 are cancelled and new claims 13-40 are added. Reconsideration and withdrawal of the rejections in view of the foregoing amendments and the following remarks is respectfully requested.

#### **I. FORMAL MATTERS**

The Office Action objects to claim 1 and rejects claims 2-5, 7, 11 and 12 under 35 U.S.C. §112, second paragraph, as allegedly indefinite. By this Amendment, all of these claims have been canceled. Accordingly the objection and the rejection are moot.

#### **II. PRIOR ART REJECTIONS**

The Office Action rejects claims 1-5 and 10-12 under 35 USC §103(a) over European Patent No. 0,574,634 to Kwok, in view of European Patent No. 0,070,933 to Frades. The Office Action also rejects claim 6 under 35 USC §103(a) over Kwok, in view of Frades, and further in view of U.S. Publication No. 2002/0037760 to Kawamura et al. The Office Action further rejects claims 7-9 under 35 USC §103(a) over Kwok, in view of Frades, and further in view of U.S. Patent No. 5,601,490 to Nakagawa et al. Because claims 1-12 have been canceled, these rejections are moot.

#### **III. NEW CLAIMS 13-40**

By this Amendment, new claims 13-40 are added to the application. Claim 13 is directed to a remote controller for controlling an electric toy vehicle. Claim 19 depends from claim 13 and recites a toy vehicle system that includes a remote controller recited in claim 13, along with a track and a toy vehicle. Claim 36 is a new independent method claim directed to a method of controlling a toy vehicle. For the reasons provided below,

it is respectfully submitted that each of these claims is allowable over the references of record.

Claim 13 recites a remote controller that includes at least one user actuable element that generates an input signal, a processor, and a transmitter. Claim 13 recites that the processor receives an input signal from the user actuable element and generates a digital vehicle control signal having a digital waveform that includes an address portion identifying a specific toy vehicle and a vehicle operation control portion that instructs a toy vehicle to take a particular action. Claim 13 recites that the transmitter couples the digital vehicle control signal to the electrically conductive traces of a toy vehicle track.

The Kwok reference discloses a toy vehicle controller which generates a digital vehicle control signal. However, Kwok teaches that the control signal should be transmitted wirelessly to a toy vehicle. This requires the remote controller to include a wireless transmitter, and it requires the toy vehicle to include a wireless receiver. Kwok fails to disclose or suggest transmitting a digital vehicle control signal over electrically conductive traces of a track.

The Frades reference discloses a control system which transmits control signals over the electrically conductive traces of a track. However, the Frades control system does not create digital vehicle control signals. Instead, the control circuits of the Frades control system are designed to generate analog control signals. Frades teaches that each of the vehicles would receive its control signal at a particular frequency. However, the control signal is not a digital vehicle control signal as recited in claim 13, which includes both an address portion and a vehicle operation control portion.

It is respectfully submitted that one of ordinary skill in the art would have had no motivation to modify the teachings of Kwok or Frades to arrive at a remote controller as recited in claim 13. Nothing in either reference discloses or suggests that it would be possible to replace the controller of the Frades system with the controller disclosed in Kwok so that the digital vehicle control signals generated by the Kwok controller are transmitted over the electrically conductive traces of a toy vehicle track. In fact, doing

so would require that the toy vehicle used in the Frades system be considerably more complex than the disclosed toy vehicles, which would greatly increase the cost of the system. For at least these reasons, it is respectfully submitted that the combination of references is improper.

Moreover, as noted above, neither reference provides any teaching or motivation to modify the Frades system, based on the teachings of Kwok, to arrive at a system as recited in claim 13, nor does either reference show how that would even be possible. Accordingly, it is respectfully submitted that it requires the impermissible use of hindsight, in view of Applicants' invention, to find a motivation to selectively combine portions of Kwok and Frades to arrive at the claimed system. For these additional reasons, it is respectfully submitted that the combination is improper.

Because Kwok and Frades cannot properly be combined to reject claim 13, it is respectfully submitted that claim 13 is allowable.

Claim 19 recites a toy vehicle system which includes the remote controller of claim 13, along with a toy vehicle track and a toy vehicle. It is respectfully submitted that claim 19 is allowable for all the reasons discussed above in connection with claim 13, and for the additional features which it recites.

Claim 36 is directed to a method of controlling a toy vehicle. Claim 36 recites generating a digital vehicle control signal having a digital waveform that includes an address portion and a vehicle operation control portion, and transmitting the digital vehicle control signal over at least one electrically conductive trace of a toy vehicle track. Claim 36 further recites receiving, at a toy vehicle, the digital vehicle control signal, the toy vehicle receiving the digital vehicle control signal via an electrical pick up that contacts at least one electrically conductive trace of the track. As explained above, none of the references of record disclose or suggest a method that includes these steps.

In view of the foregoing, it is respectfully submitted that claims 13, 19 and 36 are allowable over the references of record. The remaining claims depend from those claims are allowable for at least the same reasons, and for the additional features they recite.

**IV. CONCLUSION**

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. If the Examiner believes that additional changes would place the application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

The Commissioner is authorized to charge the undersigned's deposit account #14-1140 in whatever amount is necessary for entry of these papers and the continued pendency of the captioned application.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

**/JOHN C. EISENHART/**

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